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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,210	03/28/2001	Eiji Kawai	450100-03085	2355

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William S. Frommer, Esq.
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary

Application No.

09/819,210

Applicant(s)

KAWAI, EIJI

Examiner

Naresh Vig

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1 – 26 are rejected under 35 USC § 102 (e) as being unpatentable over broadcasting service provider DISH Network (www.dishnetwork.com) hereinafter known as DishNetwork.

Regarding claims 1, 2, 9, 12, 13, DishNetwork discloses a method and system for sales activity for selling their broadcast accessing equipment to allow subscribers to access their services. DishNetwork system allows users to purchase the equipment directly from the factory (via internet or telephone), or, from a local dealer. Customers have choice of equipments they can purchase, and pay accordingly for the equipment they have purchased. DishNetwork system offers choice of program service packages, and allows the customers to

select service they want. In addition to packaged services, DishNetwork system allows users to select from optional services for additional monthly charges.

Regarding claim 3, DishNetwork does not disclose license agreement with the manufacturer. Although, DishNetwork discloses that an interested person can contact them to get the information on becoming a dealer. It is notoriously known that manufactures sell products directly to consumers. For example Dell Computers selling peripherals like printers and monitors in addition to the products they manufacture. Also, it is inherent that there is a licensing agreement when dealerships are formed.

Regarding claims 4, 5, 14 and 15, DishNetwork discloses that a user can purchase the essential equipment at a current offered price directly from the factory, or, through a local retailer or a dealer. DishNetwork does not disclose its dealers to have a method or system to set selling price for the essential equipment, although, DishNetwork disclose to ask the users to contact the retailers and distributors directly to review the available options. It is inherent that dealers have method and system to offer current sales prices for selling the essential equipment to their customers. The sales price may include any special offerings from the dealer in addition to the offering from DishNetwork.

Regarding claim 6, DishNetwork does not disclose license agreement with the manufacturers of different components of the system. Although, DishNetwork discloses that it works with various suppliers. For example "Engineering and Technical Services, Inc. of Melbourne, Florida and TIW Services, Inc. of Santa Clara, California provided all satellite earth station equipment. TIW supplied Echostar (parent company of DishNetwork) with four, 13-meter, TV uplink antennas for its direct broadcast satellite service. "

Also, DishNetwork discloses that it offers retailers and consumers a single, seamless point of sale for programming, required hardware, and installation. Programming includes a wide variety of packaging options to suit a multitude of consumer viewing preferences and budgets, and, hardware components include an 18" satellite dish with LNBF (Low Noise Block with Feed), a programmable remote, and an MPEG-2/DVB digital satellite receiver (set-top signal descrambler). These components are supplied by different suppliers. Therefore, it is inherent that DishNetwork has agreement with its suppliers, content providers, installers dealers to make the system successful.

Regarding claims 7 and 8, it is notoriously known that DishNetwork is a broadcasting service provider and offers choice of programming packages to a customer. DishNetwork discloses of collecting charge from the user for the package the customer has selected. In addition to charges for selected package,

DishNetwork offers different optional packages and collects charge from the user accordingly.

DishNetwork does not disclose collecting actual telephone call charge from the user, instead, DishNetwork provides toll free number for users to contact their customer service. It is obvious at the time of applicant's invention to a person with ordinary skill in the art to replace toll free number with a fee based telephone number (1-900 number) and charge customers for the telephone calls to decrease amount of unnecessary calls.

Regarding claims 10 and 11, DishNetwork discloses that a user can order a DISH-On-Demand (Pay Per View) using the remote control and following step-by-step instruction on the electronic program guide (displayed on the TV). Also, DishNetwork requires the receiver to be connected to a telephone line for uploading the information to DishNetwork for billing.

Regarding claims 16 and 17, DishNetwork discloses method for sales activity for selling their equipment to allow subscribers to access their services. DishNetwork system allows users to purchase the equipment directly from the factory (via internet or telephone), or, from a local dealer. Customers have choice of equipments they can purchase, and pay according to the equipment they have purchased. DishNetwork system offers choice of services and allows the

customers to select service they want. In addition to packaged service, DishNetwork system allows users to select from optional services for additional monthly charges.

DishNetwork does not disclose license agreement with the manufacturer. Although, DishNetwork discloses that an interested person can contact them to get the information on becoming a dealer. It is notoriously know that manufacturers sell products directly to consumers. For example Dell Computers selling peripherals like printers and monitors in addition to the products they manufacture. It is inherent that there is a licensing agreement when a dealership is formed.

Also, DishNetwork controls the manufacture of the equipment by identifying the receiver box with a Serial Number, and, each receiver box requires a smart card which has its own identification. In addition, selling price offered by DishNetwork dealers may include any special offerings from the dealer in addition to the offering from DishNetwork.

Regarding claims 18 and 19, DishNetwork does not disclose that the essential parts for the equipment are supplied by the part manufacturers to the manufacturer. It is notoriously known that the manufacturers purchase the parts they need from suppliers. For example, a manufacturer purchases Printed Circuit Board (PCB) from a supplier, memory chips from another supplier, and yet shell casing from another supplier.

Also, DishNetwork discloses that a user can purchase the equipment at a current offered price directly from the factory or through a local retailer or a dealer. DishNetwork does not disclose its dealers to have a method or system to set selling price for the essential equipment, although. DishNetwork discloses to ask the user to contact the retailers and distributors directly to review the available options. Therefore, it is inherent that dealers have method and system to offer their own sales prices for selling the essential equipment to their customers. The sales price may include any special offerings from the dealer in addition to the offering from DishNetwork.

Regarding claims 20 – 22, it is notoriously known that DishNetwork is a broadcasting service provider and offers choice of programming packages to a customer. DishNetwork discloses of collecting charge from the user for the package the customer has selected. In addition to charges for selected package, DishNetwork offers different optional packages and collects charges from the user accordingly.

DishNetwork does not disclose collecting actual telephone call charge from the user, instead, DishNetwork provides toll free number for users to contact their customer service. It is obvious at the time of applicant's invention to a person with ordinary skill in the art to replace toll free number with a fee based telephone number (1-900 number) and charge customers for the telephone calls to decrease amount of unnecessary calls.

Regarding claims 23, 24 and 26, DishNetwork discloses method for sales activity for selling their equipment to allow subscribers to access their services. DishNetwork system allows users to purchase the equipment directly from the factory (via internet or telephone), or, from a local dealer. Customers have choice of equipments they can purchase, and pay according to the equipment they have purchased. DishNetwork system offers choice of services and allows the customers to select service they want. In addition to packaged service, DishNetwork system allows users to select from optional services for additional monthly charges. In addition to the equipment, customers purchase additional accessories for installation. Customers are required to pay for the subscribed programming package in advance when they activate the receiver equipment.

DishNetwork receiver equipment is identified with its own serial number. Receiver equipment has a smart card with its own identification information. DishNetwork requires both the identification information to activate the receiver box. At the time of activation, customer selects the programming package they wish to subscribe. DishNetwork charges the customer according to the package(s) selected by the customer. DishNetwork does not disclose storing the programming sales information on the receiver equipment, however, a customer can only view the channels they have subscribed from DishNetwork. Therefore, it is inherent that DishNetwork stores the purchased programming information in

the receiver equipment to control customer's access to the programs they have subscribed.

Regarding claim 25, it is known at the time of applicants invention to a person with ordinary skill in the art that in addition the receiver equipment, a customer would require the satellite dish, required cables, LNBF etc. which can be supplied by different suppliers or part manufacturers.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Information from www.dishnetwork.com disclosing general information, pricing, program packages offered to customers, ordering information.
2. Press Release "DISH Network First To Sign Nick At Nite's TV Land" discloses DishNetwork having agreement for broadcasting contents supplied by the content providers.
3. Press Releases " EchoStar Communications Adds Liberty Satellite Sports To The DISH Network Lineup" discloses DishNetwork having agreement for broadcasting contents supplied by the content providers.


4. Press Release "Echostar Joins With Gateway 2000 For Expanded Distribution" discloses DishNetwork giving special offers to of their equipment new PC customers of Gateway 2000, Inc. (PC Manufacturer).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703.746.7239 for regular communications and 703.746.7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

April 22, 2002


WYNN COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100